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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,970	06/30/2000	Kia Silverbrook	NPA015US	1454
24011	7590	05/10/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/608,970	Applicant(s) SILVERBROOK ET AL.	
	Examiner Firmin Backer	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 29th, 2005 has been entered.

Response to Amendment

2. An amendment has been file with the RCE. In the amendment, claim 1 has been amended, claims 2-10 have been canceled, and claims 11-29 have been added. Claims 1 and 11-29 are pending in the letter.

Response to Arguments

3. Applicant's arguments with respect to claims 1 and 11-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 11-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Milovanovic et al (U.S Patent No. 6,484,198) in view of Bobrow et al (U.S. Patent No

6,275,301).

6. As per claims 1 and 20, Milovanovic et al teach a method of collecting a copyright fee relating to a document when a user obtains, via coded data disposed on a surface the document, including a computer system for receiving from a sensing device placed in an operative position relative to the surface indicating data indicative of a request for the document, the sensing device generating the indicating data by sensing at least some of the coded data; and, identity data indicative of an identity of the user, the sensing device containing the identity data, identifying, from the indicating data, the request for the document, providing the document to the user using the request for the document (*see column 4 lines 5-5 line 67*). Milovanovic et al fail to teach an inventive concept of identifying from the identity data, a user account; determining the copyright fee from at least one copyright ownership; and debiting the user account associated with the user in the amount of the copyright fee. However, Bobrow et al teach an inventive concept of identifying from the identity data, a user account, determining the copyright fee from at least one copyright ownership; and debiting the user account associated with the user in the amount of the copyright fee (*see column 32 lines 11-33 line 6*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Milovanovic et al to include Bobrow et al's an inventive concept of identifying from the identity

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data, a user account, determining the copyright fee from at least one copyright ownership; and debiting the user account associated with the user in the amount of the copyright fee because this would have ensure that the user is billed accordingly, and appropriate copyright royalties flow to the copyright holder.

7. As per claims 1 and 20, Milovanovic et al teach a method of recording at least one copyright ownership relating to at least one portion of the document (*see column 4 lines 5-5 line 67*).

8. As per claims 12, 23, Milovanovic et al teach a method wherein the coded data is substantially invisible to the naked eye (*see column 4 lines 5-5 line 67*):

9. As per claims 13, 24, Milovanovic et al teach a method wherein the document includes visible information and wherein at least some of the coded data is coincident to the visible information (*see column 4 lines 5-5 line 67*).

10. As per claims 14, 25, Milovanovic et al teach a method wherein the coded data is at least partially indicative of an identity, and wherein the computer system is for determining, using the indicating data, the identity, determining, using the identity, a page description; and, identifying, using the page description, the request (*see column 4 lines 5-5 line 67*).

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11. As per claims 15, Milovanovic et al teach a method wherein the identity is at least one of: an identity of the form an identity of a region of the form; and, an identity of an interactive element (*see column 4 lines 5-5 line 67*).

12. As per claims 16, 26, Milovanovic et al teach a method wherein the coded data includes a number of data portions, each data portion having a unique data portion identity indicative of a location of the coded data portion on the form, and wherein the computer system is for determining, from the indicating data, the data portion identity of at least one sensed data portion, determining, using the data portion identity and a map, the location of the at least one sensed data portion; and, determining, using the location, the request (*see column 4 lines 5-5 line 67*).

13. As per claims 17, 27, Milovanovic et al teach a method wherein the coded data includes a number of data portions, each data portion having a data portion identity, and wherein the computer system is for determining, from the indicating data, the data portion identity of at least one sensed data portion; and, determining, using the data portion identity and the page description using the location, the request (*see column 4 lines 5-5 line 67*).

14. As per claims 18, Bobrow al teach a method of crediting at least one owner account associated with the at least one copyright ownership in the amount of the copyright fee (*see column 32 lines 11-33 line 6*).

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15. As per claims 19, 22, Milovanovic et al teach a method of printing the document (*see column 4 lines 5-5 line 67*).

16. As per claim 28, Milovanovic et al teach a system includes a relay device for receiving the indicating data from the sensing device; and, transferring the indicating data to the computer system (*see column 4 lines 5-5 line 67*).

17. As per claim 29, Milovanovic et al teach a system wherein the relay device is a printer, the printer including a first communications module for communicating with the sensing device, and, a second communications module for communicating with the computer system (*see column 4 lines 5-5 line 67*).

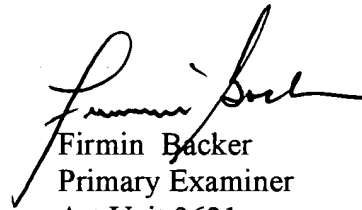
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer
Primary Examiner
Art Unit 3621

May 6, 2005